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May 2, 2011

TO: USPTO - Law Office 110
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FROM: Darin M. Klemchuk

RE: Trademark Office Action Response - Ser. No. 77881112
THRIFT FAMILY THRIFT CEBTER & Design

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Message:

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Youth Educational Services, Inc.
Mark : THRIFT FAMILY THRIFT CENTER & Design
Serial Number : 77/881,112
Filing Date : November 25, 2009
Attorney Docket No. : 1097.0005

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 2231301451

**REQUEST FOR RECONSIDERATION OF
FINAL OFFICE ACTION DATED NOVEMBER 1, 2010**

This communication is in response to the *Final Office Action* dated November 1, 2010 regarding the above-referenced trademark application. The period set for response is 6 months from the *Final Office Action* date, ending on May 1, 2011, which is extended to May 2, 2011 since May 1, 2011 falls on a Sunday. Applicant hereby responds as follows and respectfully requests reconsideration of the *Final Office Action*.

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. § 2.197

I hereby certify that this correspondence is being transmitted electronically to the United States Patent and Trademark Office, Commissioner for Trademarks on the date shown below:

<u>May 2, 2011</u>	/Claudia S. Alvarado/
Date	Claudia S. Alvarado

Applicant has carefully reviewed the *Final Office Action* dated November 1, 2010. The following response addresses each of the issues noted by the Examining Attorney, and Applicant respectfully requests reconsideration and withdrawal of the final refusal.

REMARKS

I. SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

The Trademark Office maintains the refusal to register under Section 2(d) of the Trademark Act on the basis that there is an alleged likelihood of confusion between Applicant's mark:



for "Retail stores featuring new and used clothing and new and used general consumer merchandise," in International Class 35 and the following U.S. Trademark Registration:



Mark:	
Reg. No.:	2,505,778
Services:	"Retail grocery and general merchandise store services."
Class:	35

Applicant respectfully disagrees and traverses this rejection. Applicant further requests reconsideration and withdrawal of the 2(d) refusal on the basis that there is no likelihood of confusion with the cited mark.

The standard applied to determine whether there is a likelihood of confusion in an *ex parte* examination is the same standard as applied in an infringement action. *Glenwood Laboratories, Inc. v. American Home Products Corp.*, 455 F.2d 1834, 173 USPQ 19 (CCPA 1972). That is, likelihood of confusion depends upon whether the

purchasing public would mistakenly assume that an Applicant's goods or services originate with, are sponsored by, or are in some way associated with the goods or services sold under a cited registration or trademark. *Federal Bureau of Investigation v. Societe*, 172 USPQ 310 (TTAB 1971), *aff'd*, 187 USPQ 685 (D.D.C. 1975). In determining whether there is a likelihood of confusion, several comparisons must be made. These factors include the similarity or dissimilarity in commercial impression of the marks. *In re E. I. DuPont deNemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In addition, the goods and services must be compared to determine if they are related and if the relevant market is structured such that confusion as to origin is likely or unlikely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 209 USPQ 969 (2d Cir. 1981). Other factors when present are also relevant, including whether the relevant purchasers of the goods and services are the same. See *Astra Pharmaceutical Prods. v. Beckman Instruments*, 718 F.2d 1201, 1206, 220 USPQ 786, 790 (1st Cir. 1983).

I. Comparison of Marks in Their Entireties as to Appearance, Connotation, and Commercial Impression

Regarding a comparison of the marks themselves, the Examining Attorney takes the position that "the mere addition of a term of a registered mark generally does not obviate the similarity between the marks" and "the word portion is accorded greater weight in determining likelihood of confusion."

In response, Applicant respectfully submits that the Examining Attorney focuses only on the common words between the two marks and improperly discounts the additional term in Applicant's mark and the distinctive design elements of both marks. The "fundamental rule in this situation is that the marks must be considered in their entireties." See *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (CCPA 1974). Further, the Court of Appeals for the Federal Circuit has stated that "there is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or designs dispositive of the issue." *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). Moreover, even though one feature of a mark may be more significant

in creating a commercial impression, the Examining Attorney must still view each mark in its entirety. *Tektronix, Inc. v. Kaktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *In re el Torito Restaurants, Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986). Thus, notwithstanding the overlap of the term FAMILY THRIFT CENTER in the respective marks, Applicant submits that a review of the entirety of the marks at issue reveals that they are sufficiently dissimilar in sound, appearance, connotation, and commercial impression to prevent consumer confusion.

First, the two marks are quite different in sound since Registrant's mark consists of only three words "FAMILY THRIFT CENTER", which begins with the word "Family" whereas Applicant's mark consists of four words "THRIFT FAMILY THRIFT CENTER", which begins with the word "Thrift."

Visually, Registrant's mark is a composite mark consisting of three words and an image of a fruit whereas Applicant's mark is a composite mark consisting of four words and an image of a banner. Registrant's composite mark emphasizes the words "THRIFT CENTER" and the image of the fruit. The "FAMILY" portion of Registrant's mark is small and almost unnoticeable. Therefore, consumers are more likely to focus on the more prominently displayed words and the design in Registrant's mark. On the other hand, Applicant's composite mark emphasizes the first word "THRIFT" in all capital, stylized block letters, prominently featured and positioned above the remainder of the mark "FAMILY THRIFT CENTER" presented within a banner design. Based on these clear visual distinctions between Registrant's mark and Applicant's mark, consumers will readily determine that the services offered under the two marks originate from separate sources.

The connotation and commercial impression also differ between the two marks. In particular, the schematic depiction of fruit as part of Registrant's mark carries the connotation of grocery services, which are in fact the services offered under the mark. On the other hand, Applicant's mark emphasizes the word "THRIFT", which carries the connotation of saving money and using resources carefully. As such, the visual differences between the two marks provide substantially different connotations and commercial impressions.

Applicant thus respectfully submits that a comparison of Applicant's mark and Registrant's mark reveals that the sound, appearance, connotation, and commercial impression are sufficiently different to avoid a likelihood of confusion.

2. Similarity or Dissimilarity of the Services

With respect to similarity of the services, it is the law in the Federal Circuit that a likelihood of confusion does not exist merely because identical or even similar marks are used for the same broad category of goods or services. The goods and services must also be sufficiently similar. See *Dynamics Research Corp. v. Lingen Mfg. Co.*, 704 F.2d 1575, 1576 (Fed. Cir. 1983) (no likelihood of confusion between two "DRC" marks both used for goods in the metal fabrication industry); *Electronic Design & Sales v. Electronic Data Sys.*, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992) (no likelihood of confusion between EDS and E.D.S., where both marks used for products designed for the medical field); *Reynolds and Reynolds Co. v. I.E. Sys., Inc.*, 5 USPQ2d 1749, 1752 (TTAB 1987) (mere fact that ACCU prefix both used for computers insufficient to support a likelihood of confusion).

Applicant's services are for retail store services featuring new and used clothing and new and used general consumer merchandise. The services offered under Registrant's mark, however, are for retail grocery and general store services. As is apparent from the specification of services, Applicant's services and Registrant's services are sufficiently different to avoid consumer confusion.

Consumers would not typically expect to find clothing in a grocery store or groceries in a clothing store. Therefore, the services offered under the marks are sufficiently different to avoid a likelihood of confusion as to source. Nevertheless, even if Applicant's services and Registrant's services were provided to consumers in the same type of retail store environment, this factor is not of overriding importance. *Vitarroz Corp.*, 209 USPQ at 975. For example, in *Vitarroz Corp.* the Second Circuit Court of Appeals found no likelihood of confusion between the mark BRAVO'S for crackers and the similar mark BRAVOS for tortilla chips, despite the fact that both were sold in the same grocery stores. Therefore, if the goods were sold in the same retail environment, Applicant's clothing and Registrant's groceries would be sold in entirely different sections of the store. Specifically, Applicant's clothing and Registrant's groceries would each be sold in a

dedicated section of the store. Thus, retail store consumers in the market for clothing are not likely to encounter marks associated with groceries during the purchase.

3. Concurrent Use Without Evidence of Actual Confusion

As evidence for the lack of confusion, or lack of likelihood of confusion, Applicant notes that there have been no known incidents of actual confusion between the cited mark and Applicant's mark. While the Trademark Office does not generally consider evidence of actual confusion in likelihood of confusion analysis, the "nature and extent of any actual confusion" is a factor when testing for likelihood of confusion under 15 U.S.C. §1052(d). *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (C.C.P.A. 1973). Applicant has used its THRIFT FAMILY THRIFT CENTER and Design mark since October of 2009 with no incidents of actual confusion among consumers. Additionally, Applicant has used another word mark FAMILY THRIFT CENTER since 1978 with no incidents of actual confusion. While the test is for likelihood of confusion, the absence of any actual confusion for such an extended period of time should serve as evidence that confusion is not likely. *Id.* Accordingly, concurrent use without evidence of actual confusion supports a finding of no likelihood of confusion.

II. ALTERNATIVE REQUEST FOR SUSPENSION OF APPLICATION PENDING RENEWAL OR CANCELLATION OF REGISTRANT'S MARK

In view of the foregoing, Applicant respectfully submits that there is no potential for a likelihood of confusion between Applicant's mark and the cited registration. However, if the Trademark Office is not persuaded to withdraw the refusal, Applicant respectfully requests that the present application be suspended pending the renewal or cancellation of the cited U.S. Trademark Registration No. 2,505,778.

It is within the discretion of the Examining Attorney to approve a suspension under 37 CFR §2.67, which states that "action by the Patent and Trademark Office may be suspended for a reasonable time and for good and sufficient cause." Such good and sufficient cause exists in the present case because Applicant does not believe that Registrant is currently using the mark as registered. Registrant is due to file a Section 8 & 9 Combined Declaration of Use and Application for Renewal (the "Renewal") on

November 13, 2011. Applicant does not believe that Registrant will be able to provide an appropriate trademark specimen to support the Renewal because Registrant is using the mark in a materially altered form that Applicant submits is ineffective to show current use of the registered mark. For example, the registered mark appears as a black and white stylized composite mark with the phrase "Family Thrift Center." The word "Family" is in smaller font and has a line underneath it. The entire word portion has an additional line underneath and a picture of a fruit on the right side.

Family Thrift Center 

However, the mark appears in substantially modified form on Registrant's website, www.familythriftctr.com and in a manner that provides a different commercial impression. The image of the fruit, now clearly an apple, is larger, more schematically depicted, positioned behind the "F" in "Family" and moved to the left side of the mark. Moreover, the words "Family Thrift" are now the same size, with the word "Center" set below in a smaller font and inside a box. Additionally, the words "Food & Pharmacy" now appear below the mark.



Applicant believes that Registrant has not used the cited mark for quite some time, and therefore, Registrant will be unable to provide either a specimen showing current use of the registered mark sufficient to support the Renewal or a Section 8 Declaration of Excusable Nonuse. Instead, Applicant believes that Registrant is not entitled to renew the cited registration. TMEP § 1604.11 ("Use of the mark as an essential part of a materially different composite mark does not excuse the failure to use the mark at issue."); *see also In re Continental Distilling Corp.*, 354 F.2d 139, 117 USPQ 300 (C.C.P.A. 1958). Because either failure to file or rejection of the Renewal will

ultimately result in cancellation of the cited Registration, Applicant respectfully requests suspension of the present application until the registered mark is either renewed or cancelled.

III. APPLICANT CLAIMS 2(F) DISTINCTIVENESS IN PART IN RESPONSE TO DISCLAIMER REQUIREMENT

Applicant traverses the disclaimer requirement on the basis that Applicant considers "Family Thrift Center" a separately protectable, source-indicating and distinctive mark, as evidenced by co-pending U.S. Trademark Application No. 85/001,182 for the word mark FAMILY THRIFT CENTER.

In the alternative, while Applicant disagrees that the mark FAMILY THRIFT CENTER is merely descriptive of Applicant's services, in the interest of advancing prosecution, Applicant submits that the "Family Thrift Center" portion of the present application is entitled to protection under Section 2(f) at least because Applicant has been using the mark FAMILY THRIFT CENTER for nearly 33 years, and as such, this mark has developed secondary meaning and has acquired distinctiveness. Applicant has also spent considerable amounts of time and money advertising its services under the FAMILY THRIFT CENTER mark over the course of 33 years. Applicant operates numerous stores and places advertisements in area newspapers promoting its services. Therefore, consumers have come to associate the mark FAMILY THRIFT CENTER with Applicant as a primary source identifier.

IV. NOTICE OF APPEAL

Applicant is concurrently filing a *Notice of Appeal* to preserve its right to file an Appeal Brief before the Trademark Trial and Appeal Board should the *Final Office Action* be maintained in view of the present *Request for Reconsideration*.

V. CONCLUSION

The present Request for Reconsideration is intended to fully address each of the issues raised in the *Final Office Action* dated November 1, 2010. Applicant respectfully requests reconsideration and withdrawal of the present objections. It is further believed that the application is ready for publication and subsequent registration, and such action is respectfully requested.

Applicant's attorney requests that the Examining Attorney contact the undersigned if further clarification is needed or if a telephone conference would be useful in resolving the issues pending in this matter.

Sincerely,

/Darin M. Klemchuk/

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